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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/796,973	03/11/2004	Kazuto Shimada	Q79845	4017

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WASHINGTON, DC 20037

EXAMINER
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GILLIAM, BARBARA LEE

ART UNIT	PAPER NUMBER
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1752

DATE MAILED: 08/11/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/796,973

Applicant(s)

SHIMADA ET AL.

Examiner

Barbara L. Gilliam

Art Unit

1752

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3,5,6,8 and 9 is/are rejected.
- 7) ☒ Claim(s) 2,4 and 7 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☒ Certified copies of the priority documents have been received in Application No. 10/146,465.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 3/11/04.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

1. Claims 1-9 are present.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 8 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- a. Groups R<sup>3</sup>-R<sup>8</sup>, Y<sup>1</sup>, Y<sup>2</sup>, Ar<sup>1</sup>, Ar<sup>2</sup> and Z<sup>a-</sup> of General formula (a) are not defined.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 3, 5-6, 8-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Leon et al. (US 6,190,830 B1).

- a. The heat-sensitive imaging layer of the imaging member taught by Leon et al. meets the present limitations for the photosensitive composition. Specifically the heat-sensitive imaging layer of Leon et al. is coated onto a suitable support and

comprises a crosslinked vinyl polymer containing recurring organoonium groups such as organoammonium, organophosphonium, or organosulfonium groups (abstract; column 5, line 1 – column 6, line 64; column 10, line 10-28). Useful anions include halides, carboxylates, sulfates, borates and sulfonates (column 5, lines 25-31). The crosslinked vinyl polymer meets the present limitations for the onium salt having at least two cation parts. Polymers represented by Structure IV contain “Y” and “Z” groups which are derived from ethylenically unsaturated polymerizable monomers (column 6, line 65 – column 8, line 12). A mixture of polymers can be used (column 8, lines 13-25). When a mixture of polymers are used, the polymer comprising ethylenically unsaturated groups meet the present limitations for the compound having a polymerizable unsaturated group. The infrared absorbing dyes taught by Leon et al. meet the present limitations for the light-heat converting agent (column 8, line 44 – column 10, line 3).

### ***Allowable Subject Matter***

6. Claims 2, 4 and 7 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

7. The following is a statement of reasons for the indication of allowable subject matter:

a. There is no teaching or suggestion to add a binder to the heat-sensitive layer of the imaging element taught by Leon et al. in US 6,190,830 B1. Additionally,

Art Unit: 1752

Leon et al. do not teach the specific onium salts represented by general formulae (II) and (III) and required in present claim 4.

### ***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

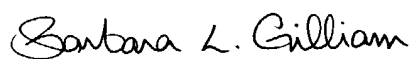
a. In US 5,512,418, Ma teaches an infra-red sensitive aqueous processable element containing an active layer, wherein the active layer comprises a cationic polymer containing pendant ammonium groups, an infra-red absorbing material and an optional colorant (abstract).

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Barbara L. Gilliam whose telephone number is 571-272-1330. The examiner can normally be reached on Monday through Thursday, 8:00 AM - 5:30 PM.

a. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on 571-272-1526. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 1752

b. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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Barbara L. Gilliam  
Primary Examiner  
Art Unit 1752

bg  
August 4, 2004